

## **REMARKS/ARGUMENTS**

Claims 1-12 remain pending in the present application, claims 13-21 having been cancelled in the foregoing amendments as being withdrawn from consideration in response to a restriction requirement.

## **Affirmation of Election and Reasons for Traversal**

The Office Action of October 1, 2003, set forth the basis for a restriction requirement between Group I claims 1-12, drawn to a method of operating a fuel cell, and Group II claims 13-21, drawn to a fuel cell assembly.

In a telephone conversation with Examiner Chaney on September 22, 2003, applicants made a provisional election with traverse to prosecute Group I claims 1-12. Applicants hereby affirm this election, but maintain their traversal of the restriction requirement on the basis that the Group I and Group II claims are sufficiently related in technical subject matter that the Group II claims could readily be searched and examined together with the elected Group I claims.

As indicated at the outset of these Remarks, applicants have cancelled withdrawn claims 13-21 in the foregoing claim amendments. Such cancellation is without prejudice to pursue

those cancelled claims in one or more continuing applications filed during the pendency of the present application. Applicants also reserve the right to reassert those claims in the present application should applicants request reconsideration of the restriction requirement before the close of prosecution on the merits of the elected claims.

### **Indefiniteness Rejections under 35 U.S.C. §112**

As to the indefiniteness rejection of claims 1-12, set forth on pages 3-4 of the October 1, 2003 Office Action, claim 1 has been amended to clarify the meaning of "mean life expectancy." Applicants submit that persons skilled in the technology involved here would readily discern "mean life expectancy" to indicate the average time to failure of a plurality of fuel cells, such as, for example, by measuring the time to failure of a plurality of fuel cells and then calculating the average time to failure.

### **Obviousness Rejections under 35 U.S.C. §103**

Claims 1-12 were rejected under 35 U.S.C. §103(a) for obviousness in view of McElroy U.S. Patent No. 6,589,678. To overcome the obviousness rejection, applicants are submitting herewith two declarations that establish an actual date of

invention of the subject matter of the present application that is before the effective date of the McElroy patent.

The accompanying Declaration of Gregory James, the first named inventor of the present application, as well as the accompanying Declaration of David Wainwright, a witness to the inventors' preparation and submission to their employer/assignee (Ballard Power Systems Inc. of Burnaby, B.C., Canada) of an Invention Memo that establishes a date of invention of the subject matter claimed in the present application that is prior to the September 28, 2000 filing date of the McElroy patent. Mr. James states in his Declaration that he prepared and transmitted to David Wainwright, a patent agent in Ballard's Intellectual Property Group, a copy of Ballard Invention Memo No. 300 (Exhibit A to his Declaration), which Mr. Wainwright signed as a witness on July 12, 2000. Mr. James further states that Item 4 of Ballard Invention Memo No. 300 discloses the concept of operating a fuel cell supplied with a fluid stream, the fuel cell having a mean life expectancy, in which the method of operation comprises reversing the direction of flow of the fluid stream after a time period of operation of the fuel cell. Mr. James further states that all of the pages of Exhibit A were written and based upon work that he and his co-inventor, Rajeev Vohra,

performed prior to September 28, 2000, which is the filing date of McElroy U.S. Patent No. 6,589,678.

In the Declaration of David Wainwright, Mr. Wainwright confirms that he is a patent agent in Ballard's Intellectual Property Group and that he received a copy of Ballard Invention Memo No. 300 from Mr. James on July 12, 2000. Mr. Wainwright further states that, in accordance with his normal practice in receiving Invention Memos from Ballard inventors, he signed Ballard Invention Memo No. 300 as a witness on the day he received it, namely, July 12, 2000.

Since applicants have established, through the accompanying Declarations of Gregory James and David Wainwright, an actual date of invention of the claimed subject matter that is before the effective date of the McElroy patent, applicants submit that McElroy no longer qualifies as a prior art reference under 35 U.S.C. §§102/103, and that obviousness rejection of claims 1-12 should be withdrawn.

\* \* \* \* \*

In view of the foregoing amendments and remarks, applicants submit that claims 1-12 are allowable. The Examiner is invited

to telephone the applicants' undersigned attorney at (312) 775-8123 if any unresolved matters remain.

Please charge any fees incurred in connection with this submission to Deposit Account No. 13-0017.

Respectfully submitted,



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Dated: December 31, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D. C. 20231, on 12-31-03  
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ROBERT W. FIESELER

Name of applicant, assignee, or

Registered Representative



Signature

12-31-03

Date of Signature